



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1459
Alexandria, Virginia 22313-1459
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/623,068 | 08/26/2000 | Ralph Evan McGinnis | | 6879 |

7590 12/29/2003
Robert McGinnis
1575 West Kagy Boulevard
Bozeman, MT 59715

EXAMINER
HORLICK, KENNETH R

ART UNIT PAPER NUMBER

1637

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,068

Applicant(s)

MCGINNIS ET AL.

Examiner

Kenneth R Horlick

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003 and 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,8,20,21,33-35,38,50,51,78-80,83,95 and 99-159 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,8,20,21,33-35,38,50,51,78-80,83,95, and 99-159 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. (2 pages)
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/03 has been entered.

2. Claims 102, 115-117, 119, 121-126, and 143-159 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) New claim 102 (previously claim 97) is rejected as before under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This apparatus claim is confusing because it cannot be determined from the specification what structural components satisfy the recited "means plus function" language. The claims require "means for determining information..." and "means for transforming...information...". Current practice under 35 U.S.C. 112, sixth paragraph requires that "means plus function" language in claims be limited to the "means" as set forth in the specification. However, the instant specification does not appear to describe even a single specific embodiment of what apparatus components are to be construed

as the "means" in the claims. The portions of the specification pointed out in the prior response, at page 6, merely describe the apparatus in terms of functional definition, rather than exemplify an actual apparatus and its structural elements. The general description of "oligonucleotide technology" and "mass spectrometry" in the specification does not remedy this problem, as this does not set forth any structural components of an apparatus.

In the response filed 07/18/03 it is argued that the specification discusses embodiments of apparatus components with specific structural elements. Copies of articles describing such components, which were incorporated by reference in the specification, were supplied. However, it is submitted that it is still not possible to understand what apparatus is contemplated in the claim. The specification and noted references merely refer to a myriad of admittedly well known technologies and devices used therein; there is clearly no indication in the specification as to what actual elements or components are contemplated in the claimed apparatus, let alone why such an apparatus might be patentable. It is suggested that if applicants are interested in apparatus-type claims in future applications, they may wish to consider non-means plus function claims which clearly specify the apparatus components.

B) Claims 115-117, 119, 121-126, and 145-159 are confusing because of a parenthetical in claims 115, 119, and 145 – it cannot be determined whether or not this represents a required limitation, especially given the language "preferentially". It is

Art Unit: 1637

suggested that this parenthetical be deleted, and the claims be clarified as is appropriate.

C) Claims 143 and 144 are confusing because they are drawn to an "apparatus as in claim 142", but claim 142 is drawn to a method rather than an apparatus. Thus it cannot be determined what is being claimed.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3, 33, and 78 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2, 3, and 4 of copending allowed Application No. 10/037,718. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Regarding instant amended claim 3 and claim 2 of the '718 application, while these claims are no longer identical, it is stated in the response filed 07/18/03 that the amendment to instant claim 3 "does not change the scope of the claim".

Art Unit: 1637

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4, 5, 8, 20, 21, 34, 35, 38, 50, 51, 79, 80, 83, 95, 99-101, and 103-159 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 of copending allowed Application No. 10/037,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are clearly obvious species in light of the genus claims of the '718 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 3-5, 8, 20, 21, 33-35, 38, 50, 51, 78-80, 83, 95, and 99-159 are free of the prior art, but are rejected for other reasons. No claims are allowable.

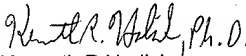
Application/Control Number: 09/623,068
Art Unit: 1637

Page 6

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Horlick whose telephone number is 703-308-3905 (571-272-0784 in Jan. 2004). The examiner can normally be reached on Monday-Thursdays 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Kenneth R Horlick
Primary Examiner
Art Unit 1637

12/23/03